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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,390	09/29/2003	Mark Bernard Hettish	2003P08063US	4143

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Attn: Elsa Keller, Legal Administrator
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EXAMINER

PADMANABHAN, KAVITA

ART UNIT PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/673,390	Applicant(s) HETTISH ET AL.	
	Examiner Kavita Padmanabhan	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are pending.
2. Claims 1-21 are rejected.

Information Disclosure Statement

3. The following items on the information disclosure statement filed 9/29/03 have not been considered as to their merits because the document numbers do not match the listed applicant name: Cite No. I and K.

Specification

4. The disclosure is objected to because of the following informalities:

It is suggested that the repeated word "that" be removed at page 4, line 11.

Appropriate correction is required. The citations above are not meant to be exhaustive, and are provided as examples. The applicant is advised to correct other similar errors as required throughout the specification.

Claim Objections

5. **Claims 10-11** are objected to because of the following informalities:

Claim 10 recites "a first context" and "said new context" in lines 2-3 of the claim.

It is suggested that these be changed to --a first identity context-- and --said new identity context-- to be consistent with other claims, such as claims 1, 2, and 3, for example.

Similarly, **claim 11** recites "said new context" in line 2 of the claim. It is suggested that this be changed to --said new identity context-- to be consistent with other claims, as explained above.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 13** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "said step of providing data indicative of said device context" in lines 2-3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

The examiner will apply prior art to this claim as best understood in light of the above rejection.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-7, 12-17, and 20-21** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract

(i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the instant case, **claims 1-7 and 12-17** recite a method but the method claimed does not produce a useful, concrete and tangible result.

For example, **claim 1** results in mapping a new identity context to a device context. This is merely an abstract idea and does not conclude in an actual result. **Claims 2-7 and 12-17** are similarly nonstatutory. Claims 8-11 appear to overcome the deficiencies of the claims from which they depend.

Claim 20 recites an article of manufacture comprising a computer readable medium having instructions that, when executed, cause a processor to perform a method that is substantially the same as the method recited in claim 1, and is similarly nonstatutory.

Claim 21 recites an apparatus comprising a processor, a communication port, and a storage device storing instructions that perform a method that is substantially the same as the method recited in claim 1. This is equivalent to reciting a computer-implemented method, as it is merely form over substance. As a result, claim 20 is nonstatutory for the same reasons given for claim 1 as explained above.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-21** are rejected under 35 U.S.C. 102(b) as being anticipated by **Diacakis et al.** (US 2002/0116336, hereinafter “Diacakis”).

In regards to **claim 1**, **Diacakis** teaches a method, comprising the steps of:

- receiving a request to make a change to a new identity context for an identity (**Diacakis; par [0031], lines 18-21; par [0034], lines 8-18; par [0046], lines 4-7; par [0048], lines 1-2**); and
- mapping said new identity context to a device context for a device associated with said identity (**Diacakis; par [0031], lines 18-25; Fig. 2; par [0032]; par [0034], lines 8-18; par [0035], lines 1-9; par [0045]; Fig. 8**).

In regards to **claim 2**, **Diacakis** teaches the method of claim 1, wherein the step of receiving said request to make said change to said new identity context for said identity includes receiving said request from an identity context oriented application (**Diacakis; par [0034], lines 8-18; Fig. 4**).

In regards to **claim 3**, **Diacakis** teaches the method of claim 1, wherein said step of mapping said new identity context to said device context for said device associated with said identity includes determining said device (**Diacakis; par [0031], lines 18-25; Fig. 2**).

In regards to **claim 4**, **Diacakis** teaches the method of claim 3, wherein said step of mapping said new identity context to said device context for said device associated with said identity includes determining said device context associated with said device (**Diacakis; par [0031], lines 18-25; par [0045]; Fig. 8**).

In regards to **claim 5**, **Diacakis** teaches the method of claim 1, wherein said step of mapping said new identity context to said device context for said device associated with said identity includes accessing a mapping table (**Diacakis; Fig. 2**).

In regards to **claim 6**, **Diacakis** teaches the method of claim 1, further comprising the step of:

- determining said device (**Diacakis; par [0031], lines 18-25; Fig. 2**).

In regards to **claim 7**, **Diacakis** teaches the method of claim 1, further comprising the step of:

- determining said device context for said device (**Diacakis; par [0031], lines 18-25; par [0045]; Fig. 8**).

In regards to **claim 8**, **Diacakis** teaches the method of claim 1, further comprising the step of:

- providing data indicative of said device context (**Diacakis; Fig. 8**).

In regards to **claim 9**, **Diacakis** teaches the method of claim 8, wherein said step of providing data indicative of said device context includes providing said data indicative of said device context to a presence and availability service (**Diacakis; Fig. 4; Fig. 8**).

In regards to **claim 10**, **Diacakis** teaches the method of claim 1, further comprising the step of:

- changing an identity context for said identity from a first context to said new context in response to said request (**Diacakis; par [0034], lines 8-18; par [0046], lines 4-7; par [0048], lines 1-2**).

In regards to **claim 11**, **Diacakis** teaches the method of claim 10, further comprising the step of:

- providing data indicative of said new context (**Diacakis; Fig. 8**).

In regards to **claim 12**, **Diacakis** teaches the method of claim 1, further comprising the step of:

- registering with a presence and availability service (**Diacakis; par [0031]**).

In regards to **claim 13**, **Diacakis** teaches the method of claim 12, wherein said step of providing data indicative of said device context includes providing said data indicative of said device context to said presence and availability service (**Diacakis; Fig. 8**).

In regards to **claim 14**, **Diacakis** teaches the method of claim 1, further comprising steps of:

- detecting a new device context for a second device, wherein said second device is associated with a second identity (**Diacakis; Fig. 8; par [0056], lines 9-17; par [0062], lines 1-12**); and
- mapping said new device context to an identity context for said second identity (**Diacakis; Fig. 8; par [0056], lines 9-17; par [0062], lines 1-12**).

In regards to **claim 15**, **Diacakis** teaches the method of claim 14, wherein said step of detecting said new device context for said second device includes detecting said new device context in a presence and availability service (**Diacakis; Fig. 4**).

In regards to **claim 16**, **Diacakis** teaches the method of claim 14, wherein said step of detecting said new device context for said second device includes receiving a request to change said second device's device context (**Diacakis**; par [0029], lines 4-7; par [0031]; par [0034], lines 14-18; par [0053], lines 6-11; par [0057]).

In regards to **claim 17**, **Diacakis** teaches the method of claim 14, wherein said step of mapping said new device context to said identity context for said second identity includes determining said second identity (**Diacakis**; Fig. 8; par [0056], lines 9-17; par [0062], lines 1-12).

Claim 18 is rejected with the rationale given for claims 8 and 10, taken together.

Claim 19 is rejected with the rationale given for claim 9.

Claim 20 is rejected with the rationale given for claim 1.

Claim 21 is rejected with the rationale given for claim 1.

Conclusion

Art Unit: 2161

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kavita Padmanabhan
Assistant Examiner
AU 2161

April 10, 2006

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